

10-16-06

1744

FW



Express Mail No.: EV 673965872 US

---

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

---

Application Number: 10/538,964  
Filed: June 14, 2005  
Applicants: Doug Sweet, Marc Key, Gordon Feingold, Kristopher Buchanan, Bob Lathrop, John Favuzzi  
Title: A Method and Apparatus for Automatic Staining of Tissue Samples  
Assignee: Dako Denmark A/S  
Attorney Docket: P131 US 01  
Customer No. 33549

---

**LETTER OF TRANSMITTAL**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed with this correspondence are the following documents:

1. Submission of Information Disclosure Statement pursuant to 37 CFR 1.97 (b)(3);
2. Information Disclosure Statement pursuant to 37 CFR §1.97(b)(3) and copies of foreign references and other documents cited;
3. This Letter of Transmittal; and
4. A Certificate of Express Mailing for each document and a return receipt post card.

I have this 12 day of October, 2006, either myself personally or through my direction of staff at this office, deposited all of the items in the above letter of transmittal with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Please confirm receipt of the documents by applying your date stamp on the enclosed postcard and returning it to me.

Dated this 12 day of October, 2006.

Respectfully Submitted,  
SANTANGELO LAW OFFICES, P.C.

By: Nicole A. Rensue  
Nicole A. Rensue  
Attorney for Assignee  
USPTO No. 48,665  
125 South Howes, Third Floor  
Fort Collins, Colorado 80521  
(970) 224-3100



Express Mail No.: EV 673965872 US

---

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

---

Application Number: 10/538,964  
Filed: June 14, 2005  
Applicants: Doug Sweet, Marc Key, Gordon Feingold, Kristopher Buchanan, Bob Lathrop, John Favuzzi  
Title: A Method and Apparatus for Automatic Staining of Tissue Samples  
Assignee: Dako Denmark A/S  
Attorney Docket: P131 US 01  
Customer No. 33549

---

**SUBMISSION OF INFORMATION DISCLOSURE STATEMENT  
PURSUANT TO 37 C.F.R. 1.97(b)(3)**

The applicant respectfully requests consideration of the attached Information Disclosure Statement. Pursuant to 37 C.F.R. 1.97(b)(3), no fee is required.

In accordance with 37 C.F.R. §1.97(b)(3), this Information Disclosure Statement is filed before the mailing date of a first office action (to the Applicant's best knowledge). As a means of complying with the duty of disclosure set forth in 37 C.F.R. §§1.56, 1.97, and 1.98, the following information may be material to the examination of the referenced application. Pursuant to 37 C.F.R. Section 1.97(g), this Information Disclosure Statement should not be construed as a representation that a search has been made. Additionally, pursuant to 37 C.F.R. §1.97(h) the filing of this Information Disclosure Statement shall not be construed as an admission that the information cited is or is considered to be material to patentability as defined in 37 C.F.R. 1.56(b). A copy of each item listed under Foreign References and Other Documents is enclosed.

Dated this 12 day of October, 2006.

Respectfully submitted,  
SANTANGELO LAW OFFICES, P.C.

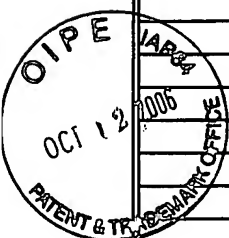
By: Nicole A. Rensue  
Nicole A. Rensue  
Attorney for Assignee  
USPTO No. 48,665  
125 South Howes, Third Floor  
Fort Collins, Colorado 80521  
(970) 224-3100



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  INFORMATION DISCLOSURE STATEMENT BY APPLICANT	APPLICATION NO:	10/538,964
	FILING DATE:	6/14/2005
	FIRST NAMED	Doug Sweet
	ART UNIT:	1744
	EXAMINER NAME:	
	DOCKET NO:	P131 US 01

# I. US PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NO. & KIND CODE (if known)	PATENTEE OR APPLICANT NAME	PUBLICATION/ISSUE DATE mm/dd/yyyy	Pages, Columns, Lines Where Relevant Passages Or Relevant Drawings Appear
	3,219,416	Natelson	11/23/1965	
	3,398,935	Livesey, et al.	8/27/1968	
	3,547,064	Binnings, et al.	4/6/1971	
	3,680,967	Englehardt	8/1/1972	
	3,772,154	Isenberg et al.	11/13/1973	
	3,853,092	Amos et al.	12/10/1974	
	3,854,703	Gibbs et al.	12/17/1974	
	3,909,203	Young et al.	9/30/1975	
	3,916,157	Roulette et al.	10/28/1975	
	4,013,038	Rogers et al.	3/22/1977	
	4,066,412	Johnson et al.	1/3/1978	
	4,113,437	Duff et al.	9/12/1978	
	4,133,642	Nosaka et al.	1/9/1979	
	4,159,875	Hauser	7/3/1979	
	4,200,056	Johnson	4/29/1980	
	4,200,607	Suzuki	4/29/1980	
	4,245,967	Busselet	1/20/1981	
	4,298,571	DiFulvio et al.	11/3/1981	
	4,406,547	Aihara	9/27/1983	
	4,447,395	Englar et al.	5/8/1984	
	4,455,280	Shinohara et al.	6/19/1984	
	4,467,603	Wilson	8/28/1984	
	4,567,748	Klass et al.	2/4/1986	
	4,585,622	Bowe et al.	4/29/1986	
	4,643,879	Hanaway	2/17/1987	
	4,647,432	Wakatake	3/3/1987	
	4,664,526	Scheffler et al.	5/12/1987	
	4,675,299	Witty et al.	6/23/1987	
	4,678,894	Shafer	7/7/1987	
	4,681,741	Hanaway	7/21/1987	
	4,683,120	Meserol et al.	7/28/1987	
	4,692,308	Riley, et al.	9/8/1987	
	4,708,886	Nelson	11/24/1987	
	4,719,087	Hanaway	1/12/1988	
	4,727,033	Hijikata et al.	2/23/1988	
	4,729,661	Bell	3/8/1988	
	4,764,342	Kelln et al.	8/16/1988	



4,774,055	Wakatake et al.	9/27/1988	
4,795,613	Azuma et al.	1/3/1989	
4,795,710	Muszak et al.	1/3/1989	
4,808,380	Minekane	2/28/1989	
4,815,978	Mazz et al.	3/28/1989	
4,824,641	Williams	4/25/1989	
4,849,177	Jordan	7/18/1989	
4,855,110	Marker et al.	8/8/1989	
4,865,811	Newton et al.	9/12/1989	
4,900,513	Barker et al.	2/13/1990	
4,919,887	Wakatake	4/24/1990	
4,933,147	Hollar et al.	6/12/1990	
4,943,415	Przybylowicz et al.	7/24/1990	
4,961,906	Andersen et al.	10/09/1990	
4,965,049	Lillig et al.	10/23/1990	
4,985,206	Bowman et al.	01/15/1991	
4,988,482	Weston	1/29/1991	
5,031,797	Boris et al.	7/16/1991	
5,051,238	Umetsu et al.	9/24/1991	
5,059,393	Quenin et al.	10/22/1991	
5,075,079	Kerr et al.	12/24/1991	
5,102,624	Muraishi	4/7/1992	
5,106,583	Raysberg et al.	4/21/1992	
5,122,342	McCullochh et al.	6/16/1992	
5,180,606	Stokes et al.	01/19/1993	
5,250,262	Heidt et al.	10/5/1993	
5,311,426	Donohue et al.	5/10/1994	
5,316,452	Bogen et al.	5/31/1994	
5,316,728	Hayashi et al.	5/31/1994	
5,331,176	Sant' Anselmo et al.	7/19/1994	
5,338,358	Mizusawa et al.	8/16/1994	
5,350,697	Swope et al.	9/27/1994	
5,355,695	Kawaguchi et al.	10/18/1994	
5,365,595	Kanamori et al.	10/18/1994	
5,424,036	Ushikubo	6/13/1995	
5,656,493	Mullis et al.	8/12/1997	
6,083,490	Ellis et al.	7/4/2000	
6,097,995	Tipton et al.	8/1/2000	
6,248,590	Malachowski	6/19/2001	
6,335,208	Lowry	1/1/2002	
6,420,916	Freeman	7/16/2002	
6,872,901	Copeland et al.	12/7/2004	
6,943,029	Copeland et al.	9/13/2005	
2002/0091593	Fowler	7/11/2002	
2002/0116132	Rhett et al.	8/22/2002	
2003/0099573	Tseung et al.	5/29/2003	
2005/0038676	Showalter et al.	2/17/2006	

	2005/0159982	Showalter et al.	7/21/2005	
	2006/088928	Sweet et al.	4/27/2006	
	RE 28585	Amos et al.	2/3/1975	
	RE 30,730	Duff	9/1/1981	
	2006/0172426	Buchanan et al.	8/3/2006	
	2006/0062365	Welcher et al.	3/23/2006	
	2006/046298 A1	Key et al.	3/2/2006	
	2006/0088940	Feingold et al.	4/27/2006	
	2006/0045806	Winther et al.	3/2/2006	
	2006/0085140	Feingold et al.	4/20/2006	



## II. FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	Foreign Patent Document Country Code, Number, Kind Code (if known)	PATENTEE OR APPLICANT NAME	PUB'N DATE mm- dd-yyyy	TRANSLATION Yes No	
	EP 0285851 A2	Fuji Photo Film Co., Ltd.	10/12/1988		
	EP 0290018 A2	Abbott Laboratories	11/9/1988		
	FR 2239167	Ministere de L'Agriculture, Service Veterinaire	7/26/1973		
	GB 2216 259	Microvol Limited	3/31/1988		
	JP 55107957	Agency of Ind Science & Technol	8/19/1980		
	WO 03/052386 A1	Lab Vision Corporation	6/26/2003		
	WO 8503571	Hulette	8/15/1985		
	WO 87/00086	American Hospital Supply Corp.	1/15/1987		
	WO 88/02866	Serono Diagnostics Partners	4/21/1988		
	WO 8802865	Weston	4/21/1988		
	WO 89/01616	Arthur Harris	2/23/1989		
	WO 9113335	Immunodiagnostics, Inc.	9/5/1991		
	JP 54014287 A	Toshiba Corp.	2/2/1979		





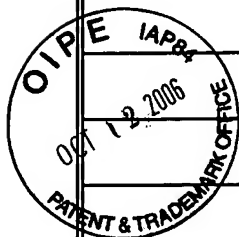


### III. OTHER REFERENCES

EXAMINER INITIAL	Document
	CHOW et al., "Application of Existing Technology to Meet Increasing Demands for Automated Sample Handling," <i>Clinical Chemistry</i> , 36(9):1579-1582, 1990.
	DRICSOLL et al., "Discreet Automated Chemistry System with Tableted Reagents," <i>Clinical Chemistry</i> , 29(9): 1609-1615, 1983.
	GARZA et al., "Bar Codes in the Clinical Laboratory," <i>Clinical Laboratory Science</i> , 4(1):23-24, Jan/Feb 1991.
	INNIS et al., "DNA Sequencing with <i>Thermus Aquaticus</i> DNA Polymerase and Direct Sequencing of Polymerase Chain Reaction-Amplified DNA," <i>Proc. Natl. Acad. Sci</i> , 85:9436-9440, December 1988.
	International Application Number PCT/US03/40880 Written Opinion dated September 28, 2005
	LINDEMAN et al., "Evaluation of the Automation of the Immunoenzymatic Procedures in a Routine Histo/Cytopathological Laboratory," <i>Histopathology</i> , 6:739-746, 1982.
	RAPPAPORT, "If Bar Code Works in Supermarkets, It Should Be Great for Medicine," <i>Pathologist</i> , 39(2): 39-40, 185.
	SAIKI et al., "Enzymatic Amplification of $\beta$ -Globin Genomic Sequences and Restriction Site Analysis for Diagnosis of Sickle Cell Anemia," <i>Science</i> 230:1350-1353, 20 December 1985.
	Stark et al., An automated Device of Immunocytochemistry, <i>Journal of Immunological Methods</i> , 1988, Elsevier, 107, pp. 89-92
	TILZER et al., "Use of Bar Code Labels on Collection Tubes for Specimen Management in the Clinical Laboratory," <i>Arch Pathol Lab Med</i> , 112:1201-1202, Dec. 1988.
	US Patent Application Number 10/054,535, Entitled Automated Biological Reaction Apparatus, now Patent number 6,943,029, the entire wrapper
	United States nonprovisional Application No. 07/488,601, "Automated Biological Reaction Apparatus" filed March 02, 1990
	United States nonprovisional Application No. 07/924,052, "Automated Biological Reaction Apparatus" filed August 31, 1992
	United States District Court, District of Arizona, Ventana v. Cytologix, CIV 02117 TUC(WDB) Defendant's Surreply in Opposition to Plaintiff's Motion for Preliminary Injunctive Relief filed July 2002
	United States District Court, District of Arizona, Ventana v. Cytologix, CIV02117 TUC (RCC) Plaintiff's Motion for Temporary Restraining Order filed March 2002
	United States District Court, District of Arizona, Ventana v. Cytologix, CIV 02117 TUC (RCC) Plaintiff's Memorandum in Support of Petition for Temporary Restraining Order and Permanent Injunction filed March 2002
	United States District Court, District of Arizona, Ventana v. Cytologix, CIV 02117 TUC (WDB) Ventana's Reply in Support of its Motion for Preliminary Relief filed June 2002
	United States District Court, District of Arizona, CV03-92 TUC-RCC, Ventana Medical vs Biogenix Laboratories, Order and Opinion on Motion, August 23, 2005
	United States District Court, District of Arizona, CV03-92 TUC-RCC, Ventana Medical vs Biogenix Laboratories Reporter's Transcript of Proceedings (Markman Hearing) before Honorable Raner C. Collins, August 11, 2005.



	United States District Court, District of Arizona, CV03-92 TUC-RCC, Ventana Medical vs Biogenix Laboratories, Order filed October 4, 2005
	United States District Court, District of Arizona, CV03-92 TUC-RCC, Ventana Medical vs Biogenix Laboratories, Judgment in a Civil Case, October 19, 2005
	United States District Court, District of Delaware, Ventana v. Dakocytomation California, CIV041522 (GMS) Order Construing the Terms of U.S. Patent No. 6,827,901 dated December 13, 2005
	United States District Court, Eastern District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Defendant's Statement of Undisputed Material Facts, in Support of its Cross-Motion for Summary Judgment of Infringement of the 861 Patent filed January 2004
	United States District Court, Eastern District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Defendant's Memorandum in Opposition to Plaintiff's Motion for Summary Judgment of No Infringement, and in Support of Defendant's Cross-Motion for Summary Judgment of Infringement of the 861 Patent, filed January 15, 2004
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Defendant's Statement of Material Facts in Dispute, in Opposition to Plaintiff's Motion for Summary Judgment of No Infringement of the 861 Patent, filed January 15, 2004
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Memorandum and Order filed September 30, 2004
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Plaintiff's motion for Summary Judgment of Non-Infringement Based on Collateral Estoppel filed October 7, 2005
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Plaintiff's Statement of Undisputed Facts in Support of its Motion for Summary Judgment of Non-Infringement Based on Collateral Estoppel, filed October 7, 2005
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Plaintiff's Memorandum in Support of its Motion for Summary Judgment of Nonfringement Based on Collateral Estoppel, filed October 7, 2005
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Declaration of Richard Wydeven in Support of Plaintiff's Motion for Summary Judgment of Non-Infringement Based on Collateral Estoppel, filed October 7, 2005
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Defendant Ventana Medical Systems, Inc.'s Memorandum in Opposition to Vision's Motion for Summary Judgment of Non-Infringement Based on Collateral Estoppel, filed October 21, 2005
	United States District Court, District of Massachusetts, Vision Biosystems (USA) Trading v. Ventana Medical Systems, CIV 03CV10391GAO, Defendant Ventana Medical Systems, Inc.'s Statement of Material Facts in Dispute, in Opposition to Vision's Motion for Summary Judgment of Non-Infringement Based on Collateral Estoppel, filed October 21, 2005
	International Preliminary Examination Report, P142WO01, International Application No. PCT/US03/40519 filed December 19, 2003
	International Preliminary Examination Report, P143WO01, International Application No. PCT/US03/40591 filed December 19, 2003



	International Preliminary Examination Report, P131WO01, International Application No. PCT/US03/40518 filed December 19, 2003
	International Preliminary Examination Report, P139WO01, International Application No. PCT/US03/40880 filed December 22, 2003
	International Preliminary Examination Report, P140WO01, International Application No. PCT/US03/00877 filed December 15, 2003
	International Preliminary Examination Report, P144WO01, International Application No. PCT/US03/41022 filed December 22, 2003
	International Preliminary Examination Report, P145WO01, International Application No. PCT/US03/40520 filed December 19, 2003, mailing date March 27, 2006
	Written Opinion, P145WO01, International Application No. PCT/US03/40520 filed December 19, 2003
	International Preliminary Examination Report, P145WO01, International Application No. PCT/US03/40520 filed December 19, 2003, mailing date May 31, 2005
	Written Opinion, P149WO01, International Application No. PCT/US03/40974 filed December 19, 2003
	International Preliminary Examination Report, P149WO01, International Application No. PCT/US03/40974 filed December 19, 2003
	Provisional Patent Application No. 60/487,998 filed July 17, 2003, "An Interface Point Server"
	U.S. Patent Application No. 11/119,417 filed April 30, 2005, "Method and Apparatus for Pretreatment of Biological Samples"
	Taylor, C., Creating a bar code chemistry system, Medical Laboratory Observer, 1993 Feb;25(2):34-6.
	Singer, R. et al., Selection and evaluation of laboratory instrumentation in clinical chemistry: II Guidelines for selection and evaluation, Med Lab Sci. 1987 Jan;44(1):6-14.
	Rocks, B. F. et al., Automatic analysers in clinical biochemistry, B F Rocks et al 1986 Clin. Phys. Physiol. Meas. 7 1-29
	Pearson, L. S., The use of bar coding technology, Medical Device Technology, March 1994
	Lifshitz, M. S, et al., Talking about Technology, Clinical Laboratory Management Review, 1989 Jan-Feb;3(1):53-4.
EXAMINER:	DATE CONSIDERED
EXAMINER: Please initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.	



Express Mail No.: EV 673965872 US

---

IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

---

Application Number: 10/538,964  
Filed: June 14, 2005  
Applicants: Doug Sweet, Marc Key, Gordon Feingold, Kristopher Buchanan, Bob Lathrop, John Favuzzi  
Title: A Method and Apparatus for Automatic Staining of Tissue Samples  
Assignee: Dako Denmark A/S  
Attorney Docket: P131 US 01  
Customer No. 33549


---

**CERTIFICATE OF EXPRESS MAILING**

I, Cheryl A. Swanson, hereby certify to the truth of the following items:

1. I am an employee of Santangelo Law Offices, P.C., 125 South Howes, Third Floor, Fort Collins, Colorado 80521.
2. I have this day deposited the attached Submission of Information Disclosure Statement pursuant to 37 CFR 1.97 (b)(3); Information Disclosure Statement Pursuant to 37 CFR §1.97(b)(3) and copies of foreign references and other documents cited; Letter of Transmittal; and return post card with the United States Postal Service as Express Mail, postage prepaid, for mailing to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Dated this 12<sup>th</sup> day of October, 2006.

  
\_\_\_\_\_  
Cheryl A. Swanson